

REMARKS

This is a full and timely response to the final Official Action mailed **April 6, 2004** (Paper No. 9). Reconsideration of the application in light of the following remarks is respectfully requested. Claims 1-15, 17, 18, 20-25, 27-30, 34-39, and 41-43 are currently pending.

In the outstanding final Office Action, claims 1-3, 5-6, 25-27, 34 and 35 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the teachings of the Handbook for Palm VII Organizer (“Palm Handbook”) *taken alone*. In the Advisory Action of August 16, 2004, the Examiner supplemented this rejection by citing U.S. Patent No. 4,817,034 to Hardin et al. (“Hardin”). For at least the following reasons, this rejection is respectfully traversed.

As Applicant has pointed out previously, claim 1 recites:

A portable computing device, comprising:
a user interface having a touch-sensitive display that detects contact between an input device and the display;
a processor; and
a memory that stores a location indicated by a user on the display;
wherein said location is determined by detecting contact between the input device and the display, any movement of the input device across and in contact with the display and removal of the input device from the display; said location being where the input device is removed from the display and not where the input device initially contacts the display.
(emphasis added).

Similarly, claim 25 recites:

A method for entering data on a portable computing device having a memory, a processor, and a touch-sensitive screen, the method comprising:
detecting initial contact between an input device and the screen;
detecting any movement of the input device across and in contact with the screen;
detecting removal of the input device from the screen; and

saving a location corresponding to where the input device is removed from the screen and not where the input device initially contacts the screen.
(emphasis added).

Claim 34 recites:

A method for entering data on a portable computing device having a memory, a processor, and a touch-sensitive screen, the method comprising indicating a specific location on said screen by:

bringing an input device into contact with said screen at a first location other than said specific location;

sliding said input device across and in contact with said screen to said specific location; and

removing said input device from said screen at said specific location;

wherein said specific location is detecting and entered by detecting removal of said input device from said screen after bringing said input device into contact with said screen.

(emphasis added).

In contrast, none of the cited prior art teaches or suggests the subject matter recited in claims 1, 25 and 34. The recent final Office Action concedes that “Palm fails to explicitly teach a memory that stores a location indicated by a user of the display, wherein said location being where a[n] input device is removed from a display and not where said input device initially contacts said display.” (Paper No. 9, p. 3). Consequently, the Advisory Action cites Hardin.

Hardin teaches a method of capturing *all* the contact points between a “cursor” (22) (i.e., a stylus) and a “digitizer pad” (20) (i.e., a touch-sensitive screen). (Hardin, col. 10, line 50 to col. 11, line 23). Such a method has long been known for capturing handwriting entered into a personal digital assistant or PDA, which is the application taught by Hardin. (See, col. 11, lines 24-46).

Applicant respectfully submits that if the system captures *all* contact between the cursor and the digitizer pad to record handwriting, i.e., a signature, the system is capturing the initial contact point as a data point. This is directly contrary to Applicant’s claims which

recite “saving a location corresponding to where the input device is removed from the screen and not where the input device initially contacts the screen.” (emphasis added). Clearly, capturing handwriting, as taught by Hardin, is very different from the methods and system disclosed and claimed by the Applicant.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection of claims 1-12, 25, and 27-37 based on the Palm Handbook and Hardin should be reconsidered and withdrawn.

Dependent claims 21-24 also recite subject matter similar to that in claims 1 and 25. Consequently, the rejection of claims 21-24 should also be reconsidered and withdrawn for at least the reasons given above with respect to claims 1 and 25.

The final Office Action rejects claims 3, 4 and 39-43 as unpatentable under 35 U.S.C. § 103(a) in view of the combined teachings of the Palm Handbook and U.S. Patent No. 5,384,862 to Kung et al. (“Kung”). For at least the following reasons, this rejection is also respectfully traversed.

Claim 4 further recites a “rocker arm [that] is movable in both a rotary direction and in a linear direction.” (See Applicant’s Specification, para. 32). Claim 39 recites similar subject matter. This subject matter is not taught or suggested by the prior art of record.

In this regard, the final Office Action cites Kung as teaching a bidirectional switch 88. According to the Action, the bidirectional switch, which generates “pointing signals, in either clockwise or counterclockwise order, via the [use] of said left, right, up or down pointing

signals[,] is considered [as teaching a rocker arm movable in] a rotary direction.” (Paper No. 9, p. 8).

However, claims 4 and 39 recite a rocker arm that is movable in ***both*** a rotary direction and in a linear direction. (See Applicant’s specification, para. 0032) Kung does not teach or suggest that the bidirectional switch 88 is moveable in two different degrees of freedom, i.e., both a rotary ***and*** a linear direction.

In the Advisory Action of August 16, 2004, the Office responded to this by stating that “it is noted that the act of rocking a given rocking switch left and right or up and down, as disclosed in the prior Final Office Action, are considered to be linear movements.” Presumably, this can be interpreted to mean that the Office considers the movement “clockwise or counterclockwise” of the Kung switch (88) to be “linear” movement. Thus, it appears that the same motion of the Kung switch labeled “rotary” in the final Office Action is now labeled as “linear” in the Advisory Action. Such a contradictory reading and stretching of the prior art is an unreasonable blurring of the clear meanings of the terms rotary and linear.

Applicant’s claim very clearly recites that the rocker arm has two degrees of freedom and can move in ***both*** a rotary ***and*** a linear direction. The movement of the Kung switch can be considered rotary or, with a perhaps unreasonable stretch, be considered linear. It would never be understood by one of skill in the art to be both. One of skill in the art would clearly understand that a rotary direction is different from a linear direction. One of skill in the art would clearly understand that Applicant’s claims recite a rocker arm with two degrees of freedom, moving in both a rotary and linear fashion. One of skill in the art would also very

clearly understand that the Kung switch has only a single degree of freedom and absolutely cannot, alone, duplicate the operation of the claimed rocker arm.

Thus, as pointed out previously, Kung fails to teach or suggest all the features of claims 4 and 39. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection of claims 4, 39 and 41-43 should be reconsidered and withdrawn.

Claims 13-15, 17-18, 20-22, 29-30 and 37-38 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of the Palm Handbook, the Remote Engineering Homepage (the "REH") and U.S. Patent No. 5,384,862 to Echerer et al. ("Echerer"). For at least the following reasons, this rejection is respectfully traversed.

Claim 13 recites:

A computer aided design (CAD) system, comprising:
a main computer that runs a desktop CAD program;
at least one portable computing device that runs a portable CAD program; and
a communication link between the main computer and the at least one portable computing device, wherein the portable CAD program and the desktop CAD program are complementary to allow data to be exchanged between the main computer and the portable computing device;
wherein the portable CAD program generates a script file comprising any additions or changes made with regard to a CAD file on the portable computing device, wherein the script file is separate from the CAD file.

The Palm Handbook is cited as teaching a portable computing device that can work with a main computer. The REH is cited as teaching a CAD program that runs on a portable computing device.

Echerer teaches that an x-ray taken for use by a doctor can be stored as an electronic bitmap file. The bitmap can be displayed as an image of the x-ray. Then, "processing

enhances the image displayed and extracts information from the image as a result of an interchange of instructions and responses between CPU and user. The enhancements and information are stored in a second memory location, separate from the bitmap. A report is prepared using the information and the image together with its enhancements and/or without them; the report is stored in a third memory location and also printed on the laser printer or possibly transmitted by modem to a remote user.” (Col. 6, lines 28-37).

Citing these teachings, the final Office Action makes the unsupported leap to allege that the teachings of Echerer would obviously lead one skilled in the art to create the claimed “portable CAD program [that] generates a script file comprising any additions or changes made with regard to a CAD file on the portable computing device, wherein the script file is separate from the CAD file.” This is incorrect.

It should be noted that Echerer does not teach or suggest “additions or changes” to an image file. Rather, Echerer merely teaches that the user (presumably a physician) “enhances the image and extracts information from the image.” Obviously, the physician does not add to or change the x-ray image. Thus, the file manipulation taught by Echerer is of an entirely different kind than that claimed by the Applicant.

In response to this, the Advisory Action cites Echeret at col. 6, lines 19-24 which state that:

Identifying information is affixed to the received image. The affixed information includes: the patient's name and number, the name of the doctor assigned to the case, the doctor's identification number, the date of the X-ray, and perhaps the X-ray description. The bitmap is stored in such a way that changes are inhibited and then displayed on a high resolution monitor.

Thus, the “identifying information” is affixed to and “stored in” the X-ray bitmap. Thus it is part of the original image file and is *entirely irrelevant* to the claimed “additions or changes” that are stored in a *separate* script file.

Moreover, nothing in the cited prior art teaches or suggests that the techniques of Echerer could or should be applied to working with a CAD program and CAD file. The teachings of Echerer are applied only to medical imaging. There is nothing in the prior art to suggest to one of skill in the art that the teachings of Echerer might be applied to a portable CAD program and CAD file.

Consequently, the combined teachings of the Palm Handbook, REH and Echerer fail to teach or suggest that “*additions or changes* made with regard to a CAD file on the portable computing device” are stored in a script file, “wherein the script file is separate from the CAD file.” (emphasis added). Moreover the cited combination fails to teach or suggest any techniques for use with a CAD program and CAD file.

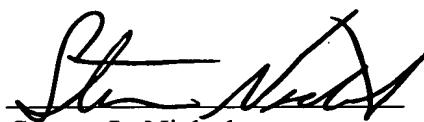
Additionally, Echerer does not expressly teach or suggest that the described enhancements and extracted information are stored in a separate file, only in a different memory location. Data stored in different memory locations can still be part of the same file. Thus, it is reading more into Echerer than is actually there to state that Echerer teaches creating a script file separate from a main file.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection of claims 13-24 should be reconsidered and withdrawn.

Dependent claims 7-10, 12, 28 and 36 were rejected under 35 U.S.C. § 103(a) in view of the combined teachings of the Palm Handbook and the REH. Claim 11 was rejected on the same basis and further in view of U.S. Patent No. 5,907,705 to Carter. Claims 23 and 24 were rejected under 35 U.S.C. § 103(a) over the combined teachings of the Palm Handbook, Echerer and Kung. These rejections are all traversed for at least those reasons given above with regard to the respective independent claims.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

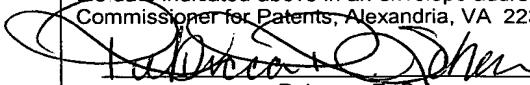
DATE: 7 September 2004

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095
(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF MAILING

DATE OF DEPOSIT: September 7, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date indicated above in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.



Rebecca R. Schow